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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/730,575

12/08/2003

Menashi A. Cohenford

11.036011

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09/15/2006

CYTYC CORPORATION  
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EXAMINER

WOOLWINE, SAMUEL C

ART UNIT

PAPER NUMBER

1637

DATE MAILED: 09/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/730,575

Applicant(s)

COHENFORD, MENASHI A.

Examiner

Samuel Woolwine

Art Unit

1637

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 18 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 3-16 and 18.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

JEFFREY FREDMAN  
PRIMARY EXAMINER

9/11/06

Continuation of 5. Applicant's reply has overcome the following rejection(s): The rejection of claim 17 under 35 USC 112, second paragraph is moot since the claim has been cancelled.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments with regard to the rejection of claims 1-16 and 18 under 35 USC 103 are not persuasive. In particular, where Applicant points out that one or another reference does not teach a particular claim limitation or the invention as a whole, such arguments are not persuasive because a rejection under 35 USC 103 is based on a combination of references. Applicant gives one specific example of a limitation which he asserts is not taught by Richards, Kurn or Kacian, this being step (c) of claims 3 and 10. However, Richards teaches this limitation (see figure 6 of Richards) except for the presence of a ribonucleotide base joining the "second primer sequence" to the 5' end of the target sequence. Rather, Richards teaches a restriction endonuclease site to allow cleaving and releasing the product. Kacian teaches an equivalent means of releasing a primer extension product, i.e. by incorporating a ribonucleotide base at the 3' end of the primer to provide a substrate for RNase H (see figure 6 and column 12, lines 12-28 of Kacian). That Applicant places the cleavable moiety on one strand or the other to release a primer which goes on to hybridize to another target is merely a functional equivalent of the mechanism of Richards which would have been obvious at the time to one of ordinary skill in the art; since hybridization takes place between only two strands, it would have been clear that placing the cleavable moiety on either strand would allow for cleaving and releasing a portion of the nucleic acid which would serve as a primer in the next step of the cascade. With regard to Applicant's arguments as to what is described in Figure 1 of the application, this is immaterial. Only what is recited in the claim itself is relevant. Arguments directed to the point that Applicant's invention involves two DNA triggering templates that are distinct from the original DNA sequence are not persuasive because this limitation is not found in the claims. Applicant's argument that there was no clear, particular suggestion to combine is incorrect. An explicit motivation to use the chimeric primer strategy of Kacian was provided on pages 6 and 7 of the Office action dated 7/10/2006..